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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,725	04/18/2001	Tomoyuki Hanai	450100-03165	9070
20999	7590	12/15/2004	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			FISH, JAMIESON W	
			ART UNIT	PAPER NUMBER
			2616	
DATE MAILED: 12/15/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/837,725

Applicant(s)

HANAI ET AL.

Examiner

Jamieson W. Fish

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statement (IDS) submitted has been considered by the examiner.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims **1-5, 7, 14** are rejected under 35 U.S.C. 102(e) as being anticipated by Susskind (US 2001/0046366).
4. Regarding claim **1**, Susskind teaches a recording schedule reservation system for programming a recording schedule of a broadcast program through a network, comprising: a program information server connected to a network, having broadcast program information and client information accumulated therein (See Fig. 2 Internet 22, Internet Remote Host Server 24, Television Listings Server 25 and Paragraphs 24, 26, 27, 35, and 36); a video recording/reproducing apparatus connected to the network for accessing said program information server to reserve a recording schedule of a broadcasting program (See Fig. 2 Video recording device 20 and Paragraph 12); and an information terminal

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apparatus for accessing said program information server to read the broadcast program information so as to select a desired broadcasting program, wherein: said program information server delivers broadcast program information of the selected broadcast program to the video recording/reproducing apparatus (See Fig. 2 Internet/Web Access Device 21 and Paragraphs 35 and 36).

5. Regarding claim 2, Susskind teaches wherein said information terminal apparatus is a portable-type information terminal apparatus (See Paragraph 30).

6. Regarding claim 3, Susskind teaches wherein said portable-type information terminal apparatus is a portable-type telephone (See Paragraph 30).

7. Regarding claim 4, Susskind teaches wherein said broadcasting program information includes: a channel number and/or starting time of a broadcasting program and/or ending time of the broadcasting program and/or actual duration of the broadcasting program and/or a video recording mode and/or a title of the broadcasting program (See Paragraphs 28 and 35).

8. Regarding claim 5, Susskind teaches wherein said information terminal apparatus capable of accessing said program information server enables said program information server to execute authentication of individuals (Paragraphs 36 and 41 and Fig. 4 "password-based secured login to user accounts" Account is accessed through web access device and authenticated by server through password).

9. Regarding claim 7, Susskind teaches wherein said video recording/reproducing apparatus programs a recording schedule based on the

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broadcasting program information delivered by said program information server  
(See Fig. 4 and Paragraph 35).

10. Regarding claim **14**, Susskind teaches wherein, whenever an improvement and/or any change is effected for broadcasting program information service in said program information server, an exactly identical improvement and/or change is applied to said information terminal apparatus and said video recording/reproducing apparatus via the network (See Fig. 4 and Paragraphs 35 and 50). The information terminal and VRD receive "current television listings." Thus would receive any improvement and/or change in the program information.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims **6, 8-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Susskind in view of Ellis (U.S. #2003/0149988).

13. Regarding claim **6**, Susskind teaches wherein said program information server to be accessed by said information terminal apparatus executes individual authentication and monitors the programs that have been recorded (See Paragraph 36 and 53). Susskind fails to disclose wherein program information server charges individuals for payment of service fee. However, having a program information server charge individuals for payment of service fee is well

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know in the art as taught in Ellis (See Fig. 1 Billing System 199 and Paragraph 61). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Susskind's program information server charge individuals for payment of service fee as taught by Ellis so the provider's of the service would receive financial compensation.

14. Regarding claim 8, Susskind teaches wherein said program information server comprises an information/control server to be accessed by said information communication terminal (See Fig. 2 Internet Remote Control Host Server 24 Paragraph 36) and a television signal provider to be accessed by said video recording/reproducing apparatus (See Paragraph 29 VRD is attached to a television signal provider which comprises broadcasting program server), wherein said information/control server and said television signal provider discretely operate on the network (See Fig. 2 and paragraph 29. The Internet Remote Control Host Server 24 is connected to the Video recording device separately for the television signal provider (not shown)). Susskind does not explicitly disclose where the television signal provider comprises a broadcasting program server. However a television signal provider comprising a broadcasting program server is well known in the art as taught by Ellis (See Paragraphs 12 and 13). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Susskind's television signal provider comprise a broadcasting program server as taught in Ellis to manage program content and information while allowing users to direct a server to record certain programs that later may be played back to the user on demand.

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15. Regarding claim 9, Susskind and Ellis teach wherein said broadcasting program server is an electronic program guide (EPG) server (See Ellis Fig. 2b Program Guide Server and Paragraph 66).

16. Regarding claim 10, Susskind and Ellis teach wherein: said information/control server accumulates broadcasting program information of the broadcasting program selected by said information terminal apparatus, and said information terminal apparatus is capable of checking the recording schedule from the broadcasting program information accumulated in said information/control server (See Susskind Paragraph 35).

17. Regarding claim 11, Susskind and Ellis teach wherein, if a recording schedule of a specific broadcasting program is erroneously input, then, said information/control server responds to said information terminal apparatus by way of informing said information terminal apparatus of the erroneously established recording schedule of the broadcasting program (See Susskind Paragraphs 35, 45, and 49).

18. Regarding claim 12, Susskind and Ellis teaches wherein said information terminal apparatus is capable of checking a recorded broadcasting program from the broadcasting program information accumulated in said information/control server (See Susskind Paragraph 36).

19. Regarding claim 13, Susskind and Ellis teaches wherein: when said information terminal apparatus selects the broadcasting program by accessing said information/control server, said information/control server accesses said broadcasting program server to set the recording schedule of the selected

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broadcasting program (See Susskind Fig. 4 and Paragraphs 35, 50 and 51); when the recording schedule of the selected broadcasting program is set, said broadcasting program server transmits the broadcasting program information of the broadcasting program set by said information/control server to said video recording/reproducing apparatus (See Susskind Fig. 4 and Paragraphs 35, 50 and 51); and when said video recording/reproducing apparatus receives the broadcasting program information, said video recording/reproducing apparatus reserves the recording schedule of the selected broadcasting program (See Susskind and Paragraphs 35, 50 and 51).

### ***Conclusion***

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamieson W. Fish whose telephone number is 703-305-0884. The examiner can normally be reached on Monday-Friday 8-5.


21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ngoc Vu can be reached on 703-305-4946. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JF 11/24/04

  
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